

REMARKS

Claims 1-23 have been examined. Claims 1-3, 5, 8-12, 14, 17, 18, 20, 21 and 23 have been rejected under 35 U.S.C. § 102(e) and claims 4, 6, 7, 13, 15, 16, 19 and 22 have been rejected under 35 U.S.C. § 103(a).

Rejections under 35 U.S.C. § 102(e)

The Examiner has rejected claims 1-3, 5, 8-12, 14, 17, 18, 20, 21 and 23 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,300,880 to Sitnik ("Sitnik").

A. Claim 1

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites that each of the third terminals includes a memory having a driver for driving a removable recording medium.

On pg. 4 of the Office Action, the Examiner acknowledges that Sitnik fails to disclose the above feature. However, in the rejection of claim 4 under 35 U.S.C. § 103(a), which contained analogous subject matter as set forth above, the Examiner takes *Official Notice* that it is old and well known in the art for mobile devices to have removable memory. The Examiner cites to U.S. Patent No. 6,771,981 to Zalewski ("Zalewski") to support the assertion of *Official Notice*.

Zalewski merely discloses a cover 100, i.e. a cell phone cover, for use as an electronic key in e-commerce, service area access or commodity purchasing (Fig. 2B; col. 8, lines 36-39).

Applicant submits that the cover 100 fails to provide proper motivation for modifying the mobile

receiver of Sitnik. For example, “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” *In re Geiger*, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 221 USPQ 929, 933 (Fed. Cir. 1984)). Also, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988, emphasis added). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 55 USPQ2d at 1316-1317; *see also* MPEP § 2142 (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”).

Here, Sitnik does not even remotely suggest recording the data it receives, let alone suggest being provided with a recording medium that is removable. For example, as disclosed in col. 20, lines 5-20 of Sitnik, the typical mobile receiver consists of a stereo headset connected to a bar code reader. The bar code reader can present price, etc. of an item to a user, while the headset allows the user to listen to a predetermined portion of a CD or record, etc. Applicant submits that it is not “old and well known in the art” to provide the claimed removable recording medium to a bar code reader, let alone the type of key card cover 100 as taught in Zalewski. In particular, the use of the cover 100 for a cell phone, to be used as an electronic key, is entirely

unrelated to the informational use of a bar code reader, as taught in Sitnik, and thus does not provide support for the Examiner's *Official Notice* position regarding the motivation for modifying Sitnik. In addition, as set forth in Sitnik, it is preferred that the mobile receivers be of low cost, size, weight, power consumption, etc., which would discourage the additional modification and use of a removable recording medium (col. 20, lines 21-37). Thus, Applicant submits that one skilled in the art would not have been motivated to modify the bar code reader of Sitnik to have a removable recording medium, as set forth in claim 1.

Accordingly, Applicant submits that claim 1 is patentable over the cited reference, and respectfully requests the Examiner to reconsider and withdraw the rejection.

B. Claims 2, 3, 5, 6 and 7

Since claims 2, 3, 5, 6 and 7 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

C. Claim 8

Since claim 8 has been canceled, without prejudice or disclaimer, Applicant submits that the rejection of such claim is now moot.

D. Claims 9, 17 and 20

Since claims 9, 17 and 20 contain features that are analogous to the features recited in claim 1, Applicant submits that claims 9, 17 and 20 are patentable for at least reasons analogous to those set forth above for claim 1.

E. Claims 10-12, 14, 18, 21 and 23

Since claims 10, 12, 14, 18, 21 and 23 are dependent upon one of claims 9, 17 and 20, Applicant submits that claims 10-12, 14, 18, 21 and 23 are patentable at least by virtue of their dependency.

Also, since claim 11 has been canceled, without prejudice or disclaimer, Applicant submits that the rejection of such claim is now moot.

Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 4, 6, 7, 13, 15, 16, 19 and 22 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sitnik in view of *Official Notice*, where U.S. Patent No. 6,771,981 to Zalewski ("Zalewski") is cited in support of *Official Notice*.

A. Claims 4, 13, 19 and 22

Since claims 4, 13, 19 and 22 have been canceled, without prejudice or disclaimer,

▪ Applicant submits that the rejection of such claims is now moot.

B. Claims 6, 7, 15 and 16

Since claims 6, 7, 15 and 16 are dependent upon one of claims 1 and 9, and the Zalewski reference fails to cure the deficient teachings of Sitnik, in regard to claims 1 and 9, Applicant submits that claims 6, 7, 15 and 16 are patentable at least by virtue of their dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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